



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,125	09/24/2003	Claus Rein	101215-151	2529

27387 7590 03/22/2005

NORRIS, MCLAUGHLIN & MARCUS, P.A.
875 THIRD AVE
18TH FLOOR
NEW YORK, NY 10022

EXAMINER

LOBO, IAN J

ART UNIT PAPER NUMBER

3662

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,125	Applicant(s) REIN, CLAUS	
	Examiner Ian J. Lobo	Art Unit 3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is noted that sole independent claim 1 is directed to a "method" and "an arrangement". The claim is rejected under 35 USC 101 based on the theory that the claim is directed to neither a "method" nor "an arrangement", but rather embraces or overlaps two different statutory classes of invention set forth in 35 USC 101 which is drafter so as to set forth the statutory classes of invention in the alternative only.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A single claim (claim 1) that claims both an apparatus and a method is indefinite.

In claim 1, line 10 specifies that the information carrier and acoustic transmitting unit are arranged in a loose contact connection. However, on line 13, it is stated that

Art Unit: 3662

the information carrier and acoustic transmitting unit do not necessarily contact each other. This discrepancy is confusing.

Finally, the antecedent for claim 15 is unclear.

Claim Objections

4. Claims 1, 6 and 10 are objected to because of the following informalities:

In claim 1, line 2, "carrierby" should be "carrier by".

In claim 6, line 6, "cermet" should be "cement".

In claim 10, line 6, the parenthetical deeply inside is questioned.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is noted all the claims 1-15 are directed to a "method" and "an arrangement". The claims are rejected under 35 USC 101 based on the theory that the claims are directed to neither a "method" nor "an arrangement", but rather embraces or overlaps two different statutory classes of invention set forth in 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-6, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of the patents to Welle ('704, '297) or Feierbach ('018).

The two patents to Welle each disclose a system for remote energy supply of an electronic information carrier (10) by a base device (30) comprising an acoustic transmitting unit (12a). The electronic information carrier (10) includes a processing unit (17), an energy supply (16, 19) and a transmitter/receiver unit (12b).

Similarly, the patent to Feierbach discloses a system for remote energy supply of an electronic information carrier (12) by a base device (16) comprising an acoustic transmitting unit (14). The electronic information carrier (12) includes a processing unit (50), an energy supply (82, 84) and a transmitter/receiver unit (80, 90).

The difference between claim 1 and the aforementioned prior art to Feierbach or Welle is the claim specifies "loose contact connection" between the transmitting device and the functional article.

However, it is arguable that Feierbach does inherently suggest a "loose contact" between the transmitting unit of the base device and the functional article since the patent is directed to a communication system through the skin of a patient. Obviously, such a communication scheme would not be a permanent contact. Likewise, although

Art Unit: 3662

not expressly disclosed, the Welle patents inherently suggest "loose contact" since the aircraft or rocket fuel tank, with the embedded sensors, (examples given) is "permanent" but the base device (3) is movable. Thus, claim 1 is so rejected as obvious over the Welle or Feierbach patents..

Dependent claims 2-6, 10 and 15 are further provided by the above noted patents.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

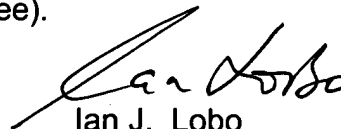
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ian J. Lobo whose telephone number is (703) 306-4161 until April 4, 2005. After April 4, 2005 the new phone number will be (571) 272-6974.

The examiner can normally be reached on Monday - Friday, 6:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas H. Tarcza can be reached on (703) 306-4171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3662

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Ian J. Lobo", is positioned above the printed name.

Ian J. Lobo
Primary Examiner
Art Unit 3662